Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALAN J. MINSHULL

Appeal No. 2003-0371
Application No. 09/465,941

HEARD: May 7, 2003

Before ABRAMS, McQUADE, and NASE, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-17, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to a method (claim 17) and apparatus (claims 1-16) for loading aircraft stringers on a jig. An understanding of the invention can be derived from a reading of exemplary claim 1, which has been reproduced below.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Peeler et al. (Peeler)	2,948,047	Aug. 9, 1960
Tenebaum et al. (Tenebaum)	3,692,363	Sep. 19, 1972
Woods	4,894,903	Jan. 23, 1990
Carlson et al. (Carlson)	5,253,454	Oct. 19, 1993

Claims 1, 3, 4, 9-11 and 14-16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Woods.

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Woods in view of Carlson.

Claims 5-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Woods in view of Tenebaum.

Claims 12, 13 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Woods in view of Peeler.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 16) for the examiner's complete reasoning in support of the rejections, and

to the Brief (Paper No. 15) and Reply Brief (Paper No. 18) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Claim 1

An aircraft assembly jig loading system comprising:

a support member;

a plurality of elongate members, each of said elongate members is attached at one end to said support member in spaced apart positions along said support member, each elongate member hanging downward from said support member; and

at least one releasable holder on each elongate member, the holders positioned to support at least one aircraft stringer at spaced apart positions to enable the stringer to be supported at an aircraft jig for loading thereon.

The Rejection Under Section 102(b)

The examiner has rejected independent claim 1 and dependent claims 3, 4, 9-11 and 14-16 as being anticipated by Woods. Anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See In re Paulsen, 30

F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994) and In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). Anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or recognition of inherent properties that may be possessed by the reference. See Verdegaal Brothers Inc. v. Union Oil Co. of California, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987). Nor does it require that the reference teach what the applicant is claiming, but only that the claim on appeal "read on" something disclosed in the reference, *i.e.*, all limitations of the claim are found in the reference. See Kalman v. Kimberly-Clark Corp, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984).

We share the examiner's view that all of the subject matter recited in claim 1 "reads on" Woods. At the outset, in arriving at this conclusion and contrary to the appellant's argument, we are of the opinion that Woods is not patentably distinguished from the claimed subject matter merely because it is not labeled as a "jig loading system." The fact is that the Woods assembly, as shown in Figure 5, is capable of functioning as a device for holding stringers for subsequent loading into another fixture. Although not described by Woods, it would appear that, in the same fashion as in the appellant's system, stringers are manually loaded into the releasable holders of the Woods device, from which they are capable of being manually loaded into another such device. The fact that Woods does not set forth the same inventive concept as the

appellant's invention does not eliminate it a proper reference, as the appellant argues, for that is not a requirement for anticipation. Verdegaal Brothers Inc. v. Union Oil Co. of California, supra.

Insofar as the structure recited in the body of claim 1 is concerned, Woods discloses an assembly comprising a support member 81, a plurality of elongate members 30 each attached at one end to the support member in spaced apart positions along the support member and hanging downward from the support member, and at least one releasable holder 60, 62 on each elongate member, the holders being positioned to support at least one aircraft stringer at spaced apart positions to enable the stringer to be supported "at" an aircraft assembly jig "for" loading thereon, as is required by the claim.

Woods therefore discloses all of the subject matter recited in claim 1, and the rejection of claim 1 as being anticipated by Woods is sustained.

Inasmuch as stringer holding clips 62 can be opened to enable a stringer to be positioned therein and released therefrom, claim 3 also is anticipated by Woods.

We reach the same conclusion with regard to claim 4, which requires that the holder be openable by means of a releasable spring clip, for Woods utilizes an openable spring clip in the "destaco" clamping system described in column 5.

The rejection of claim 9 is sustained inasmuch as each of Woods' elongate members 30 has a plurality of holders at spaced apart intervals.

Claim 10 adds to claim 9 the requirement that each holder on the elongate members overlaps an adjacent holder to provide a staggered holder arrangement. Such is not disclosed or taught by Woods, however, and therefore we will not sustain the examiner's rejection of claim 10.

Claim 11 also depends from claim 9, and recites that the holders on one of the spaced apart elongate members are aligned with the corresponding holders on an adjacent elongate member. This is disclosed in Woods in Figure 4-6 and 11, and we will sustain the rejection of claim 11.

Claim 14 is not a method claim, and does not require that the stringers be transported, as the appellant implies in his arguments (Brief, page 16). The claims states only that the holders and a stringer supported thereby be assembled "for" transport as a package. In this regard, the Wood device loaded with stringers can be transported "as a package," as is shown in Figure 1, and thus meets the terms of this claim. Claims 15 and 16 are dependent from claim 14, and the appellant has chosen not to argue their separate patentability over the applied references. The rejection of claims 14-16 is sustained.

The Rejections Under Section 103

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of

obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

The first of the Section 103 rejections is that claim 2 is unpatentable over Woods in view of Carlson. Claim 2 adds to claim 1 the requirement that the holder of each elongate member is a loop. Carlson is directed to a metal skin buffing fixture, and discloses in Figure 4A a strap 300 that holds the skin 202 to be polished on the fixture. It is the examiner's view that it would have been obvious "to use the teachings of Carlson et al. in the invention of Woods for securing the elongate members to the other supporting members of the jig" (Answer, page 4). What is lacking in this rejection is the required suggestion to combine the references in this manner. The mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In the present case, we fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the

art to modify the Woods device in the manner proposed by the examiner, and it appears to us that such is found only in the hindsight afforded one who first viewed the appellant's disclosure. We further point out it is not apparent that the Woods system would function in the manner desired if such a change were made, which would operate as a disincentive to the artisan to make the proposed modification.

Thus, Woods and Carlson fail to establish a prima facie case of obviousness with regard to the subject matter recited in claim 2, and we will not sustain this rejection.

Claims 5-8 stand rejected as being unpatentable over Woods in view of Tenebaum. Claim 5 depends from claim 1 through claims 3 and 4, with claim 3 stating that the holder recited in claim 1 can be opened to enable the stringer to be positioned therein and released therefrom, and claim 4 that this is accomplished by means of a spring clip. Claim 5 further requires that the spring clip be "clipped to a ring to close the holder." The examiner has taken the position that in view of Tenebaum's showing of using a strap attached by a spring clip to support a load in a trailer, it would have been obvious to replace the spring clips disclosed by Woods for holding the stringers in place with a strap and clip assembly. The examiner has not, however, stated why it would have been obvious for one of ordinary skill in the art to make this change to Woods, and such is not apparent to us. In the absence of suggestion to combine the references in the manner proposed by the examiner, we agree with the appellant that

this rejection is fatally defective. The rejection of claim 5 and claims 6-8, which depend from claim 5, is not sustained.

Claims 12 and 13 stand rejected as being unpatentable over Woods in view of Peeler. Claim 12 adds to claim 1 the requirement that the elongate members be flexible, which is not disclosed or taught by Woods. It is the examiner's view that it would have been obvious to replace the solid elongate members disclosed by Woods with flexible straps in view of Peeler's teaching of the use of flexible straps in building construction. However, we find ourselves in agreement with the appellants that, in fact, no such straps are disclosed by Peeler; elements 14, to which the examiner refers, are not straps but are slidable fabric cover sections (column 2, lines 27 and 28). On this basis, the rejection of claim 12 and dependent claim 13 fails at the outset, and we will not sustain it.

Claim 17 is directed to a method of packaging stringers in accordance with the system of claim 1 for subsequent assembly at a jig. The method comprises the steps of positioning a plurality of stringers in the releasable holders, forming the assembled elongate members and stringers as a package, transporting the package to an aircraft assembly jig, and lifting the support member by suitable means so as to unpack the assembly and position the stringers at the jig for loading thereon. This claim also stands rejected on the basis of Woods and Peeler. The examiner admits that Woods does not form the assembled stringers as a package, transport the package to a jig,

and lift the support means so as to unpack the assembly and position the stringers at the jig for loading thereon. However, the examiner concludes that it would have been obvious to perform these steps with the Woods device in view of the teachings of Peeler, citing Figures 1 and 2 of Peeler. We are at a loss to appreciate how the examiner proposes to modify Woods to achieve the claimed method, particularly the step of lifting the support member "to unpack the assembly," or where suggestion to do so is found in either of the references. It therefore is our conclusion that the combined teachings of these two references fail to establish a prima facie case of obviousness with regard to the subject matter of claim 17, and we will not sustain the rejection.

In the course of arriving at the above conclusions, we have carefully considered the arguments set forth by the appellant as they apply to the claims whose rejections we have sustained. However, with regard to those rejections we have sustained, these arguments have not persuaded us that the examiner's conclusion was in error. Our position with regard to these should be apparent from the explanations we have provided with regard to each sustained rejection.

CONCLUSION

The rejection of claims 1, 3, 4, 9, 11 and 14-16 as being anticipated by Woods is sustained.

The rejection of claim 10 as being anticipated by Woods is not sustained.

The rejection of claim 2 as being unpatentable over Woods in view of Carlson is not sustained.

The rejection of claims 5-8 as being unpatentable over Woods in view of Tenebaum is not sustained.

The rejection of claims 12, 13 and 17 as being unpatentable over Woods in view of Peeler is not sustained.

The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

NEAL E. ABRAMS)
Administrative Patent Judge)

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